



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,471	02/22/2007	Mikiko Kaminuma	IKUTP106US	4357

23623 7590 09/02/2010
TUROCY & WATSON, LLP
127 Public Square
57th Floor, Key Tower
CLEVELAND, OH 44114

EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
----------	--------------

1625

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

09/02/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket1@thepatentattorneys.com
hholmes@thepatentattorneys.com
setoori@thepatentattorneys.com

Office Action Summary	Application No. 10/580,471	Applicant(s) KAMINUMA ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-9 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-9 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election of group I in the reply filed on Jun. 25, 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-6, 10-26 have been canceled. Claims 1-2, 7-9, 27-34 are prosecuted to the extent of the elected scope being drawn to *glycine derivatives*. The remaining subject matter of claims 1 or 7 being drawn to aminodicarbonic acid derivatives, acylaminodicarbonic acid derivatives, pyrrolidinecarboxylic acid derivatives, piperidinecarboxylic acid derivatives, hexamethylene-iminecarboxylic acid derivatives and beta-alanine derivatives are withdrawn from consideration per 37 CFR 1.142(b). Cancellation of the nonelected invention is recommended.

2. Claims 1-2, 7-9, 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "inhibitor agent" is ambiguous and indefinite. Does it mean a "compound" that has parakeratosis inhibiting activity? Does it mean a "composition" that has parakeratosis inhibiting activity? Or does it mean the material being used for parakeratosis inhibition? The term encompassed hybrid scope. If the claims are drawn to compounds, then the particularity of what they are by name or chemical formulation must be specifically pointed out. If the claims are compositions, then the names of the active ingredients and inert carrier must be pointed out. If the claims are drawn to method of using a material for parakeratosis inhibition then they are essential duplicates of claims 28-34. Essentially duplicate claims are subject to double patenting rejection when one set is allowed, therefore, cancellation of one set is recommended.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1625

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(A) Claims 1-2, 7-9, 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kyowa et al. CA 79:22615a or CA93:210106.

Kyowa CA79 or CA93 disclosed composition comprising glycylglycine for skin application to prevent irritation or roughening which are results of parakeratosis or pore size., thus, anticipates the claims comprising glycine derivatives.

(B) Claims 1-2, 7-9, 28-29, 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu et al. US 6,824,786. See compounds and compositions of col. 11-20 for treating keratinization disturbance (col. 4, lines 1-6) and improve skin pores (col. 5, line 10). Therefore, anticipated the claims for the scope of "glycine treating ves".

(C) Claims 1-2, 7-9, 28-29, 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by JP11-158055.

See p. 3-4 English translation [0011] table of composition containing glycine for improving keratin condition of the skin.

(D) Claims 1-2, 7-9, 28-29, 32-34 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by WO2003/099327 or the pregnant publication US 2005/0152930.

See p.2 [0031] composition for shrinking pore and p.4 table 2 or example 1 composition comprising glycine which anticipated the claims.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made..

Art Unit: 1625

Claims 1-2, 7-9, 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-158055 in view of CA131:35667.

Determination of the scope and content of the prior art (MPEP §2141.01)

JP 11-158055 disclosed keratin condition improving composition and an example anticipating the scope of “glycine derivative” was clearly pointed out supra see section 3.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the dependent claims and the exemplified compound of the prior art is the glycine derivative is particularly glycylglycine. CA131:35667 provided evidence that generically, the HP 11-158055 reference disclosed both glycine and glycylglycine as alternative choices for such composition.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art in possession of the JP 11-158005 reference would be tantamount to in possession of the claims because in absence of unexpected result, there is nothing unobvious in choosing an alternative active ingredient generically disclosed by the reference. The picking and choosing among the many alternative active ingredients is expected to be operable for the intended use. In re Lemin 141 USPQ 814.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Aug. 26, 2010

/Celia Chang/
Primary Examiner
Art Unit 1625